

Appl. No. 10/738,430
Examiner: BALAOING, ARIEL A, Art Unit 26817
In response to the Office Action dated July 25, 2006

Date: October 25, 2006
Attorney Docket No. 10113501

REMARKS

Responsive to the Office Action mailed on July 25, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1-21 are pending in the application. Claims 1, 2, 4-14, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Franck et al (U.S. 6,397,081, hereinafter "Franck"). Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franck in view of Sakaguchi et al (U.S. 2002/0094841, hereinafter "Sakaguchi").

In this paper, claims 20 and 21 are amended to correct a typographical error. Namely, "elastic portion" is amended to "elastic member" so as to correspond to the recitation of the element throughout the claim.

Reconsideration of this application is respectfully requested in light of the following remarks.

Rejections Under 35 U.S.C. 102(e)

Claims 1, 2, 4-14, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Franck. Applicant respectfully traverses the rejections for the reasons as follow.

To anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Franck et al fails to teach or suggest a mobile phone with a SIM card holder comprising a sliding holder disposed in a first concave portion of a body, the holder slidable between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion, as recited in claim 1.

In the rejections, the Examiner identifies lid 26 as the alleged holder of claim 1. The Examiner further refers to col. 1, lines 35-50 and col. 3, line 64 to col. 4, line 17 to teach the limitation "the holder slidable between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion." In this regard, the Examiner states:

... lid is slid and pivoted to an overlapping and non-overlapping area of the SIM depression ...

During patent examination, the pending claims must be given their "broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Plain meaning refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. *MPEP 2111 et seq.*

The term slidable refers the ability to move along a smooth surface while maintaining continuous contact with it. *New Oxford American Dictionary, 2nd Edition.*

Claim 1 recites that the holder is slidable between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion. To the

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contrary, in Franck, lid 26 is pivoted between an overlapping and non-overlapping area of the SIM depression. In this regard, Applicant notes that while lid 26 is slidable, it slides between a locked and an unlocked position, wherein in both the locked and unlocked positions the lid is overlapping the SIM depression.

Namely, to open lid 26, it is first slid horizontally along the direction indicated by the open arrow in Fig. 3 until the locking tab 27 is released as shown in Fig. 4, at which point the lid is rotated upwards away from the body of the mobile telephone to a position not overlapping the SIM depression. This is evident in Fig. 3 (locked), Fig. 4 (unlocked), Figs. 10 and 11, and col. 4, lines 6-17 of Franck, which describe an extremely narrow range of sliding movement between depressions 45 on flaps 43. In particular, the "sliding movement of the lid 26 in closed position is allowed between extreme positions." See col. 4, lines 7-9 of Franck. Thus, the lid is "closed" (i.e., overlapping the SIM depression) when the sliding movement occurs.

The Examiner recognizes the two part opening of lid 26 himself in the office action, which states that the "is slid and pivoted to an overlapping and non-overlapping area of the SIM depression." However, as noted above, it is only the pivoting which moves the lid to a non-overlapping position. Applicant therefore submits that Franck fails to teach or suggest a holder that is slidable between a first position overlapping a second concave portion of the body and a second position not overlapping the second concave portion.

For at least the reasons described above, it is Applicant's belief that Franck fails to teach or suggest all the limitations of claim 1. Applicant therefore respectfully requests that the rejection of claim 1 be withdrawn and the claim passed to issue. Insofar as claims 2-9 and 20 depend from claim 1 either directly or indirectly, and therefore incorporate all of the limitations of claim 1, it is Applicant's belief that these claims are also in condition for allowance.

Franck fails to teach or suggest a SIM card removably disposable on the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position so as not to overlap the SIM card during disposition of the SIM card on the body, as recited in claim 10.

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As noted above, Franck does teach that lid 26 is slidable between a first position and a second position. However, in both these positions, the lid 26 is "closed". Namely, for the same reasons discussed in connection with claim 1, it is only by the pivoting of lid 26 that it moves between overlapping and non-overlapping positions. To the contrary, claim 10 recites the holder is slid to the second position (non-overlapping) from the first position (overlapping) so as not to overlap the SIM card during disposition of the SIM card on the body.

For at least the reasons described above, it is Applicant's belief that Franck fails to teach or suggest all the limitations of claim 10. Applicant therefore respectfully requests that the rejection of claim 10 be withdrawn and the claim passed to issue. Insofar as claims 11-19 and 21 depend from claim 10 either directly or indirectly, and therefore incorporate all of the limitations of claim 10, it is Applicant's belief that these claims are also in condition for allowance.

Franck fails to teach or suggest that the body includes an abutting surface between the first concave portion and the second concave portion, and the holder includes an elastic member corresponding to the abutting surface, wherein the elastic member is compressed against the abutting surface by movement of the holder from the first position to the second position, and elastic force from the compressed elastic member returns the holder from the second position to the first position when the holder is released while in the second position, as recited in claims 20 and 21.

In the rejections, the Examiner refers to col. 1, lines 36-50 and col. 3, line 9 to col. 4, line 17 of Franck to teach the elastic member of claims 20 and 21. With reference to col. 1, lines 36-50, the only teaching of an "elastic" element is the last sentence of the paragraph, which reads:

The lid has with biasing means *for biasing the integrated circuit card towards the contact elements of the terminal unit when the lid is in the locked position.*

[Emphasis added]

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The biasing feature of the lid 26 is described in col. 3, lines 36-40 and 62-65 of Franck. Specifically, the lid is curved and manufactured from a material having good elastic properties, such that lid 26 is elastically deformable. Furthermore, as described in col. 3, lines 62-65:

Due to the resilient properties of the lid 26 the SIM card *will be forced towards the contact elements 36 of the terminal unit 35 when the lid 26 is in the locked position.*

[Emphasis added]

It is therefore evident that whatever portion of lid 26 the Examiner considers to be the "elastic member" of claims 20 and 21, said portion does not have the features of being "compressed against the abutting surface by movement of the holder from the first position to the second position" and "the elastic force from the compressed elastic member returns the holder from the second position to the first position when the holder is released while in the second position", as recited in claims 20 and 21.

For example, with respect to claim 1, the holder is overlapping the second concave portion when in the first position, and the holder is not overlapping the second concave portion when in the second position. Thus, in claim 20, the elastic member is compressed against the abutting surface by movement of the holder from the first position (overlapping the second concave portion) to the second position (not overlapping the second concave portion). Furthermore, the elastic force from the compressed elastic member returns the holder from the second position (not overlapping the second concave portion) to the first position (overlapping the second concave portion) when the holder is released while in the second position.

To the contrary, in Franck there is no compression (i.e., biasing) of lid 26 against an abutting surface by movement of the lid from the closed position to an open position. Instead, biasing of the lid only occurs when the lid is snapped into a locked position wherein the curved structure is deformed. See Fig. 3 of Franck.

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Furthermore, in Franck the elastic force from the lid 26 does not return the lid from the open position to the closed position when the lid is released while in the open position. In particular, Applicant notes that lid 26 is not biased when in the open position. Thus, the user must manually rotate the lid 26 from an open position to the closed position.

Claim 10 contains limitations similar to those in claim 1 relative to the SIM card. Thus, the argument advanced in connection with claim 20 is believed to apply to claim 21 in a similar fashion. Claims 20 and 21 are therefore considered to be in condition for allowance both by virtue of their dependency from claims 1 and 10, respectively, and for the additional reasons described above.


Rejections Under 35 U.S.C. 103(a)

Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franck in view of Sakaguchi. As noted above, it is Applicant's belief that claims 3 and 15 are allowable by virtue of their dependency from claims 1 and 10, respectively. For this reason, the Examiner's arguments in connection with these claims are considered moot and will not be addressed here.

Conclusion

For the reasons described above, the Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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